REMARKS

Claims 90-163 are pending in the subject application. No claim has been added, canceled or amended herein. Accordingly, claims 90-163 are still pending and under examination.

In view of the arguments set forth below, applicant maintains that the Examiner's objections and rejections made in the April 7, 2005 Office Action have been overcome, and respectfully requests that the Examiner reconsider and withdraw same.

Rejection under 35 U.S.C. §112, first paragraph

The Examiner rejected claims 90-163 under 35 U.S.C. §112, first paragraph, as allegedly not enabling any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with the claims.

Specifically, the Examiner stated that the specification, while being enabling for methods using closed, circular nucleic acid molecules, nucleic acid molecules with two fixed ends or linear molecules which exceed 800 nucleotides, does not provide enablement for linear molecules shorter than 800 nucleotides.

In response, applicant respectfully traverses for the reasons set forth below.

The test for enablement is whether one skilled in the art could, at the time of the invention, make and use the claimed invention based on the disclosure and information known in the art without undue experimentation. Applicant maintains that the claimed invention satisfies the test for enablement, and that the Examiner has not set forth sufficient grounds for concluding otherwise.

It is noted that an applicant need not demonstrate enablement for every embodiment of a claim for the claim itself to be enabled.

The term "nucleic acid molecule" includes a wide range of molecular sizes, such as molecules of 500 base pairs and 1000 base pairs. The Examiner has conceded, for example, that the application is enabled for linear molecules which exceed 800 nucleotides.

Applicant directs the Examiner's attention to the opinion of the court in U.S. v. Telectronics Inc., 8 U.S.P.Q.2d 1217, 1222, 1223 (Fed. Cir. 1998), wherein the court held that "[s]ince one embodiment is admittedly disclosed in the specification, along with the general manner in which its current range was ascertained, we are convinced that other permutations of the invention could be practiced by those skilled in the art without undue experimentation. See SRI Int'l v. Matusushita Elec. Corp of America, 227 U.S.P.Q. 577, 586 (Fed. Cir. 1985) (the law does not require an applicant to describe in his specification every conceivable embodiment of the invention); Hybritech Inc., 231 U.S.P.Q. at 94 (the enablement requirement may be satisfied even though some

experimentation is required)."

Following the reasoning adopted by the court in U.S. v. Telectronics, applicant maintains that because the application is admittedly enabled for at least one embodiment, i.e. linear nucleic acid molecules which exceed 800 nucleotides, one of skill in the art could practice other embodiments of the invention, i.e. linear nucleic acid molecules which are shorter than 800 nucleotides, without undue experimentation. The Examiner has not provided evidence to the contrary. Specifically, the Examiner's reference to the problem of "slip through" highlights nothing more than a potential shortcoming, and not a failure, of shorter nucleic acid molecules. Such shortcomings, if they exist, do no negate the enablement of the pending claims.

In view of the above remarks, applicant respectfully maintains that claims 90-163 satisfy the requirements of 35 U.S.C. §112, first paragraph.

Double Patenting Rejection

The Examiner rejected claims 90-163 under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-76 of U.S. Patent No. 5,866,337.

In response, applicant will consider submitting a terminal disclaimer at such time as the instant claims are deemed otherwise allowable.

Rejection Under 35 U.S.C. §102(a)

The Examiner rejected claims 90-92, 94, 95, 99-103, 106-108, 110, 115-119, 121-124, 127-128, 130, 135-140, 142-146, 148, 149, 151, 154-157 and 159-163 under 35 U.S.C. §102(a) as allegedly anticipated by Nilsson et al (Science, September 1994, 265:2085-2088) ("Nilsson").

In response to the Examiner's rejection, applicant respectfully traverses for the reasons set forth below.

Applicant directs the Examiner's attention to the Declaration of Eric A. Schon, Ph.D. under 37 C.F.R. § 1.131 ("Schon Declaration"), attached hereto as **Exhibit A**, which was submitted on March 1, 1996 in connection with an Amendment in Response to November 1, 1995 Office Action for U.S. Serial No. 08/409,644, now abandoned, which is the parent of the instant application. The Schon Declaration provides evidence that the claimed invention was reduced to practice in the United States prior to September 30, 1994, the publication date of Nilsson. Therefore, in view of the Schon Declaration, applicant respectfully requests that the Examiner withdraw Nilsson as a reference against the instant claims.

In view of the above remarks, applicant maintains that claims 90-92, 94, 95, 99-103, 106-108, 110, 115-119, 121-124, 127-128, 130, 135-140, 142-146, 148, 149, 151, 154-157 and 159-163 satisfy the requirements of 35 U.S.C. §102(a).

Rejections Under 35 U.S.C. §103

The Examiner rejected claims 93, 96, 104, 105, 120, 125, 126, 141 and 147 under 35 U.S.C. §103(a) as allegedly obvious over Nilsson in view of Matthews et al. (Anal. Biochem., 1988 169:1-25).

The Examiner also rejected claims 109, 111-114, 129, 131-134, 150, 152 and 153 under 35 U.S.C. §103(a) as allegedly obvious over Nilsson in view of Thomas et al. (U.S. Patent No. 4,749,647).

Finally, the Examiner rejected claims 97, 98 and 158 under 35 U.S.C. §103 as allegedly obvious over Nilsson in view of Stein et al (Cancer Res., 1988, 48:2659-2668).

In response to the Examiner's rejections, applicant respectfully traverses.

As noted above, applicant has requested that the Examiner withdraw Nilsson as a reference against the instant claims in view of the Schon Declaration. Since the Examiner has based the above rejections under 35 U.S.C. §103(a) on the use of Nilsson as the primary reference, applicant maintains that the withdrawal of Nilsson obviates these objections. Therefore, applicant respectfully requests that the Examiner withdraw the above rejections under 35 U.S.C. §103.

In view of the above remarks, applicant maintains that claims 93, 96, 97, 98, 104, 105, 109, 111-114, 120, 125, 126, 129, 131-134, 141, 147, 150, 152, 153 and 158 satisfy the requirements of 35 U.S.C. §103.

Summary

Applicant maintains that the claims pending are in condition for allowance. Accordingly, allowance is respectfully requested.

If a telephone conference would be of assistance in advancing prosecution of the subject application, applicant's undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee, other than the $60.00 extension fee, is deemed necessary in connection with the filing of this Communication. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,

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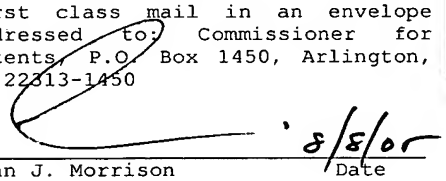
I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Arlington, VA 22313-1450



8/8/02

Alan J. Morrison
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Date